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April 21, 2009

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Art Unit 3688

Attn: Mail Stop Amendment

Re: U.S. Utility Patent Application
Application No. 10/681,587; Filing Date: October 7, 2003
For: **Hidden Image Game Piece**
Inventors: BARNHART *et al.*
Our Ref: 2743.001000E

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Information Disclosure Statement;
2. Form PTO/SB/08A (2 sheets) listing thirty-nine (39) documents (US1-US38 and FP1);
3. Form PTO/SB/08B (2 sheets) listing eleven (11) documents (NPL1-NPL11); and
4. Copies of cited documents (FP1 and NPL4-NPL11).

The above-listed documents are filed electronically through EFS-Web.

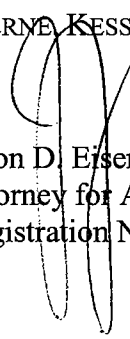
In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
April 21, 2009
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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Jason D. Eisenberg
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JDE/ahw
Enclosures

DOC#967188_1.DOC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BARNHART *et al.*

Appl. No.: 10/681,587

Filed: October 7, 2003

For: **Hidden Image Game Piece**

Confirmation No.: 6858

Art Unit: 3688

Examiner: Janvier, Jean D.

Atty. Docket: 2743.001000E

Information Disclosure Statement

Mail Stop Amendment

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying IDS Forms are documents that may be considered material to the patentability of this application as defined in 37 C.F.R. §1.56, and in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.97 and 1.98.

Applicants have listed publication dates on the attached IDS Forms based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent

application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☒ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.
- ☐ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
 - ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than

three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

☐ c. The required fee is provided through online credit card payment authorization in the amount of \$0.00 in payment of the fee under 37 C.F.R. § 1.17(p).

☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but on or before payment of the Issue Fee. The required fee is provided through online credit card payment authorization in the amount of \$0.00 in payment of the fee under 37 C.F.R. § 1.17(p); in addition:

☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than

three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

☒ 5. Some of the documents were cited in search reports by foreign patent offices in counterpart foreign applications. Submission of the search reports that indicate the degree of relevance found by the foreign office are provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38 and MPEP 609.04(a)(III).

☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below in accordance with 37 C.F.R. § 1.98(a)(3).

☒ 7. Copies of documents FP1 and NPL4-NPL11 are submitted. However, in accordance with 37 C.F.R. § 1.98(a)(2), no copies of U.S. patents and patent application publications cited on the attached IDS Forms are submitted. In addition, documents NPL2 and NPL3 (U.S. Appl. Nos. 09/517,061 and 11/341,129) are co-pending applications that are available for viewing by the

Examiner on the USPTO's IFW system, therefore copies of documents NPL2 and NPL3 are not enclosed.

- ☒ 8. A copy of the document, NPL1, was cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. 09/437,254, filed November 10, 1999, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

- ☒ 9. It is expected that the examiner will review the prosecution and cited art in the parent application nos. 10/173,529 filed June 17, 2002 (now U.S. Pat. No. 6,833,829), 09/634,111 filed August 8, 2000 (now U.S. Pat. No. 6,406,062), 09/437,254 filed November 10, 1999 (now U.S. Pat. No. 6,296,900), and 09/081,795 filed May 20, 1998 (now U.S. Pat. No. 5,984,367) in accordance with MPEP 2001.06(b) and requested that the examiner will review the prosecution and cited art in the related application nos. 09/480,656 filed January 11, 2000 (now U.S. Pat. No. 6,629,888), 10/411,363 filed April 11, 2003 (now Abandoned), 11/474,616 filed June 26, 2006, 10/173,385 filed June 17, 2002 (now Abandoned), 11/341,129 filed January 27, 2006, 09/517,061 filed March 1, 2000 (now Abandoned), 10/155,174 filed May 28, 2002 (now Abandoned), 10/463,587 filed June 18, 2003 (now Abandoned), and 09/969,063 filed October 21, 2001 (now Abandoned) and indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed IDS Forms, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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